

REMARKS

Claims 1-14, 16-54, 61-104, and 106-141 are pending in the present application. Claims 1, 17, 18, 20, 22, 24, 26, 28, 30, 32-42, 46, 62, 63, 65, 67, 69, 72, 73, 77-87, 91, 107, 108, 110, 112, 114, 116, 118, 120, 122-132, and 136 are amended. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 1-14, 16-54, 61-104 and 106-141 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

Claims 1, 46, and 91 are amended to recite "a plurality of subscribed entities" and "a plurality of entities." Claims 1, 46, and 91 are further amended to recite "wherein the plurality of subscribed entities is a subset of the plurality of entities," thus more clearly differentiating between the plurality of entities and the plurality of **subscribed** entities. Thus, a person of ordinary skill in the art would be able to make and use the claimed invention. Claims 1, 46, and 91 are also amended to more clearly recite "a plurality of dynamic contact records" and "at least one subscribed dynamic contact record" that is identified from within the plurality of dynamic contact records.

The Office Action provides no analysis for claims 136-141. Therefore, the rejection of claims 136-141 is improper. Applicants respectfully request withdrawal of the rejection of claims 1-14, 16-54, 61-104 and 106-141 under 35 U.S.C. § 112, second paragraph.

II. 35 U.S.C. § 103, Obviousness

The Office Action rejects claims 1-14, 16-54, 61-104 and 106-141 under 35 U.S.C. § 103 as being unpatentable over *Elliott et al.* (U.S. Patent Application Publication No. US 2002/0064149) in view of *Morkel* (U.S. Patent Application Publication No. US 2002/0052921). This rejection is respectfully traversed.

Elliott teaches a system and method for providing requested quality of service in a hybrid network. More particularly, *Elliott* teaches that the system provides subscribers

the ability to establish a personal home page, which provides a vehicle for people to communicate with or schedule meetings with the subscriber. The home page allows a guest to create and send text-based pager messages, create and send email messages, and access the subscriber's calendar. See *Elliott*, paragraphs [3064]-[3087]. The subscriber may use personal home page profile management features to establish and maintain contact information, as well as establish and maintain a personal calendar. See *Elliott*, paragraphs [3198]-[3206]. However, a guest must deliberately visit the subscriber's home page to get any information on the subscriber. As acknowledged in the Office Action *Elliott* does not teach or suggest sending, using the at least one status server, current dynamic contact records to a client that subscribes for the entity whose dynamic contact information is received.

Morkel teaches a system and method for managing contact information. A user can send or update personal information to selected recipients by attaching a message to an email directed to the recipients or by checking a field in an email indicating that personal information is included. See *Morkel*, paragraph [0007]. The recipient must then receive the email, open the email, and select the sender's "livecard," which includes the sender's personal information. For example, Figure 9 of *Morkel* depicts an example email message with a link to the sender's livecard. The recipient may click the link to receive the personal information. Therefore, the recipient must perform an action to receive the personal information.

In contradistinction, the present invention provides a subscription-based service for providing dynamic contact information. Claim 1, for example, recites:

1. A method in a computer system for providing dynamic contact information, said method comprising the steps of:
 - establishing a status system, including at least one status server and a plurality of clients;
 - specifying for a given client within the plurality of clients a plurality of subscribed entities for which the given client subscribes to automatic updates of dynamic contact information;
 - retrieving a plurality of dynamic contact records for a plurality of entities from one or more systems within the status system, wherein the plurality of subscribed entities is a subset of the plurality of entities;
 - providing the plurality of dynamic contact records to the at least one status server;
 - identifying at least one subscribed dynamic contact record from

within the plurality of dynamic contact records that corresponds to one of the plurality of subscribed entities; and

automatically sending, using said at least one status server, the at least one subscribed dynamic contact record to said given client without intervention from an operator of the given client.

Thus, a given client subscribes to a plurality of entities. When dynamic contact information is received for at least one of these entities, the dynamic contact information is automatically sent to the given client without intervention from an operator of the given client.

Elliott and *Morkel*, taken individually or in combination, fail to teach or suggest automatically sending dynamic contact information to subscribing clients without intervention from an operator of the subscribing clients. *Elliott* teaches a subscriber home page wherein each guest must deliberately and independently visit the subscriber home page to view any contact information. *Morkel* teaches attaching personal information to an email wherein the recipient must deliberately open the email and select a link or other control to retrieve the personal information. Neither *Elliott* nor *Morkel* teaches or suggests automatically sending dynamic contact information to subscribing clients. Therefore, the proposed combination of *Elliott* and *Morkel* would not result in the present invention, particularly as recited in amended claim 1, for example.

Moreover, the Office Action may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, *Elliott* and *Morkel* cannot be properly combined to form the claimed invention. The Office Action alleges that a person of ordinary skill in the art would have been motivated to utilize the email system of *Morkel* to update an entity whose contact information is contained in the system of *Morkel*. However, the Office Action does not explain why a person of ordinary skill in the art would be motivated to combine the email system of *Morkel* with the web-base home page system of *Elliott* or how such a combination would be possible. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only

through the an impermissible use of hindsight with the benefit of Applicants' disclosure a model for the needed changes.

Furthermore, even if *Elliott* and *Morkel* could be properly combined, the proposed combination would not form the presently claimed invention in claim 1, for example. Instead, a combination of *Elliott* and *Morkel* would result in a subscriber home page wherein a guest may retrieve and view the home page to see contact information and a separate email system wherein the subscriber may send personal information directly to individual guests.

Independent claims 46 and 91 recite subject matter addressed above with respect to claim 1 and are allowable for the same reasons. Since claims 2-14, 16-45, 47-59, 61-90, 92-104, and 106-135 depend from claims 1, 46, and 91, the same distinctions between *Elliott* and *Morkel* and the invention recited in claims 1, 46, and 91 apply for these claims. Additionally, claims 2-14, 16-45, 47-59, 61-90, 92-104, and 106-135 recite other additional combinations of features not suggested by the reference.

More particularly, claim 4 recites:

4. The method according to claim 3, further comprising the step of including within each said dynamic contact information a current telephone type, current telephone status, current telephone number, current telephone status time period, office telephone number, voice-mail status, and voice-mail checking frequency information for one of said plurality of entities associated with each said dynamic contact information.

However, contrary to the Office Action's assertions, neither *Elliott* nor *Morkel* teaches or suggests, for example, "voice-mail checking frequency information." The Office Action merely cites seemingly arbitrary portions of the reference as allegedly teaching all of the claim limitations of all of claims 2-14. However, the Office Action proffers no analysis as to why the teachings of *Elliott* and *Morkel* are somehow equivalent to the claimed invention. The applied reference fails to teach or suggest each and every claim limitation; therefore, the proposed combination of *Elliott* and *Morkel* fails to render claim 4 obvious. Claims 49 and 94 recite subject matter addressed above with respect to claim 4 and are allowable for the same reasons.

Similarly, claim 32 recites:

32. The method according to claim 17, wherein said information includes an e-mail address and e-mail checking frequency information for said one of said plurality of subscribed entities.

However, contrary to the Office Action's assertions, neither *Elliott* nor *Morkel* teaches or suggests, for example, "e-mail checking frequency information." The Office Action merely cites seemingly arbitrary portions of the reference as allegedly teaching the all of the claim limitations of all of claims 16-45. However, the Office Action proffers no analysis as to why the teachings of *Elliott* and *Morkel* are somehow equivalent to the claimed invention. The applied reference fails to teach or suggest each and every claim limitation; therefore, the proposed combination of *Elliott* and *Morkel* fails to render claim 32 obvious. Claims 77 and 122 recite subject matter addressed above with respect to claim 32 and are allowable for the same reasons.

As a further example, claim 36 recites:

36. The method according to claim 17, further comprising the steps of:
hovering a cursor over a name of said one of said plurality of
subscribed entities; and
displaying a full status message.

However, contrary to the Office Action's assertions, neither *Elliott* nor *Morkel* teaches or suggests, for example, "hovering a cursor over a name of said one of said second plurality of entities." The Office Action merely cites seemingly arbitrary portions of the reference as allegedly teaching the claim limitations. However, these cited portions make no mention whatsoever of hovering a cursor over a name and the Office Action proffers no analysis as to why the teachings of *Elliott* and *Morkel* are somehow equivalent to the claimed invention. The applied reference fails to teach or suggest each and every claim limitation; therefore, the proposed combination of *Elliott* and *Morkel* fails to render claim 36 obvious. Claims 81 and 126 recite subject matter addressed above with respect to claim 36 and are allowable for the same reasons.

The Office Action states that claims 136-141 recite a computer program product for performing the method of claims 1-14 and 16-45. Applicants respectfully disagree. Claim 136 recites:

136. A method in a data processing system for managing dynamic contact information, the method comprising:
maintaining a user status for the user, wherein the user status is provided to a group of users;
receiving dynamic contact information from a client for a user, wherein the dynamic contact information is automatically sent to the data processing system by the client in response to a change in a calendar on the client;
responsive to receiving the dynamic contact information, selectively changing the user status for the user based on receiving the dynamic contact information to form changed status information; and
automatically sending the changed status information to a plurality of subscribing users without interaction from the plurality of subscribing users.

Thus, claim 136 is clearly a method claim with different scope from claim 1. The Office Action does not establish a *prima facie* case of obviousness for claim 136, because the Office Action does not specifically address the particular combination of features recited in claim 136. Applicants submit that *Elliott* and *Morkel*, taken individually or in combination, fail to teach or suggest automatically sending dynamic contact information to a plurality of subscribing users without intervention from the plurality of subscribing users for the reasons addressed above with respect to claim 1. Since claims 137-141 depend from claim 136, the same distinctions between *Elliott* and *Morkel* and the invention recited in claim 136 apply for these claims. Additionally, claims 137-141 recite other additional combinations of features not suggested by the reference.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-14, 16-54, 61-104 and 106-141 under 35 U.S.C. § 103.

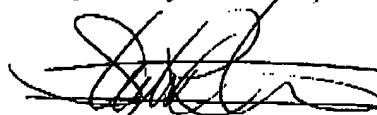
III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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